

REMARKS

The above amendment is made in response to the Office Action mailed December 8, 2003. Claim 1 has been amended. Claims 1-26 are pending in the present application. Claims 12-25 were withdrawn from consideration. Claims 1-11 and 26 stand rejected. The Examiner's reconsideration is respectfully requested in view of the above amendment and the following remarks.

Claim 1 stands rejected under 35 U.S.C. § 112, first and second paragraph. Claim 1 has been amended to overcome the § 112 rejections. Withdrawal of the rejection of claim 1 under 35 U.S.C. § 112, first and second paragraph, is respectfully requested.

Claims 1-5 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelly et al. (U.S. Patent No. 6,047,292) (hereinafter "Kelly") in view of Berry et al. (U.S. Patent No. 6,195,693) (hereinafter "Berry"). The rejection is respectfully traversed.

The Office Action does not address whether the combination of Kelly and Berry teaches or suggests "*installing in a computer the communication module...said communication module having stored codes executable by the computer to establish a communication link with the server,*" as essentially claimed in claim 1. The Office Action argues that "Berry teaches upon playback of the music stored in the multimedia medium by the computer and a server." Berry teaches *identifying* "indicia associated the audio record" in response to playing the audio recording, and *searching* the computer for a code matching the identifying indicia. (Berry, col. 4, lines 18-23). The portions of Berry cited by the Examiner do not teach or suggest "*installing in a computer the communication module,*" much less "upon playback of the stored music program stored in the multimedia medium by the computer." Because Berry does not teach installing the communication

module, it follows that Berry does not teach “said communication module having stored codes executable by the computer to establish a communication link with the server.” Thus, assuming *arguendo* that they are properly combined, the combination of Kelly and Berry does not teach or suggest “installing in a computer the communication module upon playback of the stored music program stored in the multimedia medium by the computer, said communication module having stored codes executable by the computer to establish a communication link with the server,” as essentially claimed in claim 1.

Further the combination of Kelly and Berry does not teach or suggest “gathering profile data from the user in response to a command by the communication module” and “transmitting content information based on the profile data to the used,” as amended in claim 1.

Notwithstanding the above, it further is respectfully submitted that the motivation provided by the Office Action for combining Kelly and Berry seems to be based solely on impermissible hindsight. The prior art references themselves do not provide the motivation cited by the Office Action.

Claims 6, 7, 9, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelly in view of Berry and Official Notice. The rejection is respectfully traversed.

Referring to claim 26, the Office Action summarily rejects the claim without addressing each and every limitation. The Office Action does not address whether the combination of Kelly, Berry, and Office Notice teaches or suggests “*installing the communication module* in the computer upon presentation of said entertainment content by the computer” or “communicating with a server at an *URL address stored in said*

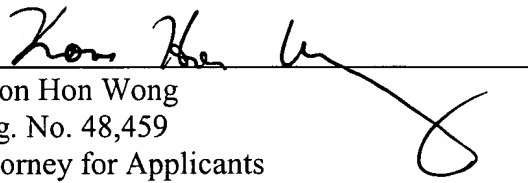
multimedia medium upon access of said icon by a user of the computer, wherein said icon *changes state to notify the user of receipt of new e-mail* from the server.” As addressed above, the combination of Kelly and Berry does not teach or suggest “installing the communication module....” Thus, assuming *arguendo* that they are properly combined, the combination of Kelly, Berry and Official Notice does not teach or suggest “installing the communication module in the computer upon presentation of said entertainment content by the computer.” Further the combination of Kelly, Berry and Official Notice does not teach or suggest “communicating with a server at an URL address stored in said multimedia medium upon access of said icon by a user of the computer, wherein said icon changes state to notify the user of receipt of new e-mail from the server.”

Additionally, the combination of Kelly, Berry and Official Notice does not teach or suggest “wherein said icon transmits a heartbeat signal to the server when the user is online” and “wherein upon access of said icon, providing the user with a plurality of profile inquiries, and transmitting user-specific advertising based on the profile inquiries to the user,” as amended in claim 26.

Accordingly, claim 1 is believed to be patentably distinguishable and nonobvious in view of Kelly and Berry. Claims 8 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelly in view of Berry and Hosken (U.S. Patent No. 6,438,579), and Kelly in view of Berry and Govindarajan et al. (U.S. Patent No. 6,208,659), respectfully. Dependent claims 2-11 are believed to be allowable for at least the reasons given for claim 1. Claim 26 is believed to be patentable distinguishable and nonobvious in view of Kelly, Berry and Official Notice. Withdrawal of the rejection of 1-11 and 26 under 35 U.S.C. § 103(a) is respectfully requested.

In view of the foregoing remarks, it is respectfully submitted that all the claims now pending in the application are in condition for allowance. Early and favorable reconsideration is respectfully requested.

Respectfully submitted,

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